

United States District Court

Eastern

DISTRICT OF

Virginia

Richmond Division

NTP, Inc.

SUMMONS IN A CIVIL ACTION

V.

CASE NUMBER: 3:08cv655

JON W. DUDAS, in his Official Capacity as Under
Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark
Office

TO: (Name and Address of Defendant)

CHUCK ROSENBERG, ESQUIRE
UNITED STATES ATTORNEY
Eastern District of Virginia
2100 Jamieson Avenue
Alexandria, Virginia 22314

2008 OCT 15 AM 11:07

Hand delivered my

YOU ARE HEREBY SUMMONED and required to serve upon PLAINTIFF'S ATTORNEY (name and address)

Maya M. Eckstein, Esq.
HUNTON & WILLIAMS LLP
951 East Byrd Street, Riverfront Plaza, East Tower
Richmond, Virginia 23219

an answer to the complaint which is herewith served upon you, within 60 days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint. Any answer that you serve on the parties to this action must be filed with the Clerk of this Court within a reasonable period of time after service.

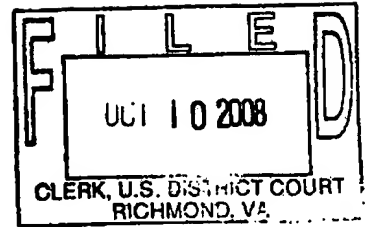
Fernando Galindo, Clerk

OCT 14 2008

CLERK

DATE

Kara Young
BY DEPUTY CLERK



**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Richmond Division**

NTP, INC.,

Plaintiff,

v.

**JON W. DUDAS, in his official capacity as
Under Secretary of Commerce for
Intellectual Property and Director of the
United States Patent and Trademark Office,**

Defendant.

Civil Action No.: 3:08cv655

COMPLAINT

NTP, Inc. ("NTP"), by counsel, alleges as follows for its Complaint against Jon W. Dudas, in his official capacity as Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office ("Mr. Dudas"):

THE PARTIES

1. NTP is a corporation organized under the laws of the Commonwealth of Virginia, with its principal place of business at 16381 Locust Hill Drive, Virginia 23146.
2. Mr. Dudas is the Under Secretary of Commerce for Intellectual Property and Director of the PTO.

JURISDICTION AND VENUE

3. This Court has jurisdiction pursuant to 28 U.S.C. § 1331 and the Administrative Procedure Action, 5 U.S.C. §§ 702 et seq.
4. The United States District Court for the Eastern District of Virginia, Richmond Division, is the appropriate venue for this action, pursuant to 28 U.S.C. § 1391(e), because NTP resides in the Richmond Division and no real property is involved in the action.

STATEMENT OF FACTS

The Telenor Documents and NTP's Analysis of their Authenticity

5. NTP is the assignee of all right, title and interest in U.S. Patent Nos. 5,436, 960; 5,438,611; 5,479,472; 5,625,670; 5,631,946; 5,819,172; 6,067,451; and 6,317,592.
6. In 2001, NTP filed suit against Research in Motion Limited ("RIM") for infringement of its patents. A jury returned a verdict of willful infringement against RIM.
7. Thereafter, in December 2002, RIM urged the PTO to initiate Director Ordered reexaminations of NTP's patents. In addition, RIM itself requested reexaminations of a number of NTP's patents. At present, there are a total of 8 reexaminations pending. Seven of NTP's patents are currently under *ex parte* reexamination. The patent numbered 6,317,592 ("592 Patent") is under *inter partes* reexamination.
8. In 2005, RIM purportedly received an anonymous tip that documents existed in the Norges teknisk-naturvitenskapelige universitet ("NTNU") library in Trondheim, Norway that described a system for remotely transmitting emails that allegedly pre-dated the claims asserted in NTP's '592 Patent. RIM obtained copies of an eight volume, loosely bound set of documents from the NTNU library, the so-called "Telenor documents", and submitted them to the PTO.
9. After learning of the existence of the Telenor documents, NTP attempted to obtain the original documents from the NTNU library for review by an expert, but was advised that the documents were checked out. As a result, NTP was unable to have the original documents examined by its expert, Dr. David Richard Browne, prior to the due date for filing its comments on the Office Action Closing Prosecution (ACP") in the *inter partes* reexamination.
10. Subsequently, when the "original" copy of the Telenor documents became available, Dr. Browne, at NTP's request, performed a number of scientific examinations and

observations on the documents. Among other things, he examined the paper contained in each of the volumes under ultra violet light, conducted microscopic examination of the staples and staple holes in the documents, and examined each page of the documents for the existence of "trash marks" left by photocopy machines.

11. Dr. Browne produced a forensic report describing his scientific findings, which included:

- Ultra violet examination revealed various pages within volumes of the Telenor documents came from different batches of paper, suggesting they were added at different points in time;
- Staples binding one volume of the report had been removed, and microscopic examination of the holes and indentation marks on the paper from a staple remover indicated the volume had previously not contained all the chapters it currently contains;
- The header on each page had been photocopied onto the document at a different time than the text on each page, suggesting the original text could have been redacted and new text copied into the body of the document;
- Trash marks from the photocopier used to reproduce the pages were not the same on each page, indicating pages were copied on different photocopies at different times; and
- Trash marks on the cover pages of the volumes were different than in the body of the documents, indicating the cover pages, which were the only pages containing dates or date stamps, were not copied at the same time and/or on the same photocopy machine as the body of the document.

12. Dr. Browne concluded from his forensic investigation that there was considerable evidence that various volumes and individual pages of the Telenor documents had been changed since their initial assembly. Dr. Browne also indicated there was doubt as to what text was actually on the pages when the volumes were first assembled.

13. Officials of the NTNU library declined to provide an affidavit or other sworn document describing the custody and control of the Telenor documents from the time these

documents were initially submitted to the library (allegedly in 1986 and 1989) until the time they were obtained by RIM for submission to the PTO in 2005. Instead, the Coordinator of Library Catalogs at NTNU, Tove Aursoy, sent an unverified email describing the library's electronic entries for the Telenor documents, which were based on the library's former card catalog system in existence when the documents were first submitted.

14. An NTP lawyer, Kevin Anderson, interviewed the librarians at the NTNU library regarding custody of the documents. The librarians indicated the volumes were checked out from time to time, sometimes for extended periods, and there was no method by which to verify whether the documents, when returned, had been altered in any way. As a result, the NTNU library could not establish the Telenor documents listed in its card catalogs in 1989 were in fact exactly the same documents currently in its possession, casting doubt on whether the documents that RIM had sent to be considered by the PTO were the same as what documents may have been submitted at the relevant time frame in 1989.

15. NTP requested that Dr. Browne, Mr. Anderson, and other persons involved in the chain of custody of the Telenor documents, including David L. Gunn, Thomas Kaufman, James Brown, and Peter Sadler prepare declarations (collectively, the "Telenor Analysis") for submission to the PTO challenging the authenticity of the documents.

The PTO Refuses to Admit the Telenor Analysis into the Record

16. In the *inter partes* reexamination, 37 C.F.R. 1.951 only permits a Patent Owner to submit a single set of comments following an ACP. Further, there is no express authority in an *inter partes* proceeding to allow entry of newly discovered evidence into the record following an ACP. NTP was concerned, therefore, that when Dr. Browne's analysis was complete, the evidence might not be admitted in the *inter partes* reexamination even though it could be

admitted into evidence in the *ex parte* reexaminations because they were at a less advanced stage of review.

17. NTP raised its concerns to the PTO in an interview on April 6, 2006 in one of the *ex parte* reexaminations (interviews are not permitted in *inter partes* reexaminations). The examiners assured NTP that all documents that came into evidence in any one of the reexaminations would be considered in all the other reexaminations. NTP memorialized this assurance in a filing with the PTO, stating as follows:

... the Office indicated during the interview that evidence and information submitted in a particular reexamination proceeding will be considered in all reexamination proceedings to ensure complete resolution of the issues. While the Office made this statement in the context of evidence relating to the authenticity of the Telenor documents, Patent Owner presumes similar consideration will be given to evidence or information that only recently become available.

See Ex Parte Reexamination Control Nos. 90/007,723 ; 90/006, 491 ; 90/006,679), Submission of Redated Supplemental Amendment/Response to Office Action of December 14, 2005 at 130-31 (emphasis added).

18. NTP was able to submit the Telenor Analysis in each of the *ex parte* reexaminations as of right and without seeking leave of the PTO. The PTO reneged, however, on its commitment to consider the Telenor Analysis in the *inter partes* reexamination.

19. On May 12, 2006, NTP petitioned the PTO for leave to file supplemental comments in the *inter partes* reexamination on the grounds that the Telenor Analysis did not exist and therefore could not have been submitted with NTP's original comments after ACP.

20. Initially, NTP's supplemental comments were accepted and uploaded onto Public Pair, the PTO's internet site that allows public access to papers filed in patent applications. However, on September 13, 2006, the PTO issued a Decision Dismissing Petition, blocking further public access to the materials.

21. The PTO objected that NTP's supplemental comments referenced documents received through the Freedom of Information Act ("FOIA") suggesting bias and improper conduct by the PTO officials. The September 13, 2006 Decision Dismissing Petition required NTP to redact all references to the FOIA documents from its supplemental comments. The Decision reserved judgment whether the Telenor Analysis would be accepted, pending receipt of a further request by NTP for waiver of 37 C.F.R. 1.951(a), which permits only a single set of comments after ACP.

22. On January 3, 2007, NTP filed a Petition requesting waiver of 37 C.F.R. 1.951(a) to submit the Telenor Analysis (which in fact was still on Public Pair but blocked from public access). By Decision dated March 30, 2007, the PTO denied NTP's Petition, rejecting submission of the Telenor Analysis in the *inter partes* matter even though the same evidence was admitted into the record of each of the 7 *ex parte* reexaminations. Additional Petitions to the PTO to allow the admission of the Telenor Analysis into the record of the *inter partes* reexamination were all rejected.

23. On April 4, 2007, NTP submitted its Appeal Brief in the *inter partes* reexamination, which referred to the Telenor Analysis and challenged the reliability of the Telenor documents. The PTO entered an order requiring NTP to withdraw the brief and redact its arguments challenging the authenticity of the Telenor documents. On August 7, 2007, NTP complied with the PTO's order by filing an Amended Appeal Brief in the *inter partes* reexamination that deleted all reference to the Telenor Analysis.

The PTO Claims NTP Failed to Proffer Evidence Challenging the Aursoy Email

24. On August 24, 2007, an Examiner's Answer was filed in the *inter partes* reexamination that responded to NTP's Amended Appeal Brief. NTP was stunned to find a

section of the Examiner's Answer entitled "The Office's Allegation that the Telenor Documents Are Printed Publications Is Supported By Evidence." This section asserted in pertinent part as follows:

[T]he Aursoy statements were introduced into the record of the current reexamination proceeding on January 10, 2006, over a year before the mailing date of this Office action, with the Appellant having had an opportunity to investigate said the alleged hearsay assertions and present rebutting evidence, even in the form of declarations and affidavits. 37 § 1.116(e). Epstein also indicated that the truthfulness of the assertions in the alleged hearsay documents can be assumed when the documents appear on their face to be accurate and reliable and Appellant fails to proffer any evidence to support arguments to the contrary. Id. at 1566. Here, there is nothing on the face of the Aursoy statements to suggest that information has been altered in any way or that the statements lacked accuracy and reliability. Furthermore, Appellant has not proffered evidence to support arguments to the contrary.

See Examiner's Answer at Page 231. *attach?*

25. Contrary to the assertions in the Examiner's Answer, NTP had in fact investigated the accuracy of the Aursoy statements as they related to the Telenor documents and had submitted its Telenor Analysis to the PTO disputing the authenticity of the documents described in the Aursoy email. NTP's proffered evidence included interviews by its counsel of NTNU librarians regarding their lack of knowledge whether the Telenor documents had been altered at any point when the documents were checked out and not under the library's custody and control. Together, NTP's declarations and the Browne report (*i.e.*, the Telenor Analysis) demonstrated the Aursoy email was not reliable evidence that the documents RIM submitted to the PTO in 2005 were identical to the documents initially submitted to the NTNU library in 1986 and 1989.

26. In response to the patently false assertion in the Examiner's Answer that NTP had never *proffered* evidence that might call into question the accuracy or reliability of the Aursoy

email, NTP submitted a Petition dated October 17, 2007 to enter into the record for appeal the Telenor Analysis it had previously proffered against the authenticity of the Telenor documents.

27. Further, on October 24, 2007, NTP filed a Rebuttal Brief responding to the Examiner's allegations that it had never proffered evidence regarding the Aursoy email. Pages 30-37 of the Rebuttal Brief argued—from documents contained in the public record of the *inter partes* proceeding and without reference to the substance of the Telenor Analysis—that the Examiner's allegations were inaccurate. The Rebuttal Brief further asserted that the Examiner had erroneously concluded the Aursoy email was entitled to a presumption of accuracy and reliability because of the alleged *absence* of contrary evidence from NTP. NTP asserted that as a matter of law, the presumption of reliability drawn by the PTO resulted from an incorrect application of the law.

28. On November 7, 2007, the PTO dismissed NTP's October 17 Petition to supplement the record with the Telenor Analysis.

29. In addition, on November 9, 2007, the Examiner mailed NTP a Notification Regarding Defective Rebuttal Brief. This notice required NTP to redact its arguments at pages 30-37 of its Rebuttal Brief. NTP was given one month to file an amended Rebuttal Brief deleting all reference to its proffered evidence. The PTO stated that failure to remedy the "defect" would preclude NTP from submission of a Rebuttal Brief on any issue.

30. NTP had no choice but to submit on December 10, 2007 a redacted version of its Rebuttal Brief in which it removed all arguments regarding the Examiner's allegations that it had not proffered evidence addressing the accuracy and reliability of the Aursoy email.

31. That same day NTP submitted a Petition Pursuant to 37 C.F.R. § 1.181, § 1.182 and § 1.183 to Withdraw the Notification Regarding Defective Rebuttal Brief Dated November

9, 2007. This petition argued that NTP faced a "Hobson's Choice: redact the entirety of pages 30-37 and concede the issue . . . or attempt at its jeopardy to amend pages 30-37 so as to comply with the Notification but run the risk that the amendments would be deemed deficient and result in the amended rebuttal brief being dismissed from further consideration in this appeal."

32. The December 10 petition argued that due process and fundamental fairness required that NTP be granted reasonable latitude to fashion legal arguments to address and counter assertions in the Examiner's Answer that NTP failed to offer any evidence challenging the accuracy and reliability of the Aursoy hearsay.

33. In order to exhaust its administrative remedies, on January 11, 2008, NTP filed a Petition for Reconsideration of the PTO's November 7, 2007 Decision dismissing its Petition to admit the Telenor Analysis into evidence.

34. On January 29, 2008, the PTO dismissed NTP's December 10, 2007 Petition requesting that the Notification Regarding Defective Rebuttal Brief be withdrawn. In order to exhaust its administrative remedies, NTP filed a timely Petition to Reconsider the PTO's January 29, 2008 Decision.

35. On June 19, 2008, the PTO issued Decisions denying both NTP's January 11, 2008 Petition to admit the Telenor Analysis into evidence and the January 29, 2008 Petition to allow into the record pages 30-37 of NTP's Rebuttal Brief.

36. On July 11, 2008, NTP filed suit in this Court seeking relief in the nature of mandamus against Mr. Dudas, in his official capacity as Under Secretary of Commerce for Intellectual Property and Director of the PTO (the "Mandamus Action"). The Mandamus Action was precipitated by the PTO's refusal, for over a year, to docket NTP's appeals or to schedule oral argument before the Board of Patent Appeals and Interferences ("BPAI"). Additionally, the

Chief Judge of the BPAI had denied NTP's motion to consolidate the appeals of its 8 reexaminations, asserting that the motion was premature because the appeals were not docketed.

37. In response to NTP's Complaint, and in order to obtain a dismissal of that Complaint, the PTO docketed NTP's appeals, assigned them docket numbers, and scheduled all 8 of NTP's reexamination for oral argument on October 28, 2008. The PTO's action, including the scheduling the *inter partes* reexamination for oral argument on October 28, is confirmed in this Court's Agreed Order of Dismissal dated September 8, 2008.

38. The PTO would not agree, in conjunction with resolution of the Mandamus Action, to supplement the record on appeal in the *inter partes* reexamination with the Telenor Analysis. Subsequently, by letter dated October 2, 2008, NTP sent the Board of Patent Appeals and Interferences ("BPAI") a draft copy of this Complaint and requested that it exercise its authority to supplement the record on appeal with the Telenor Analysis so the records in all eight reexaminations scheduled for hearing on October 28, 2008 would be identical. Since the BPAI has not responded, NTP brings this action challenging as final agency action the PTO's denial of its January 3, 2007, and January 11 and 29, 2008 Petitions.

39. The Administrative Procedure Act, 5 U.S.C. § 706(2)(A) provides that any agency action which is "arbitrary, capricious, an abuse of discretion, and otherwise not in accordance with law" is prohibited and may be overturned by a district court.

40. Due process and fundamental fairness required that the record in the *inter partes* reexamination be supplemented with the Telenor Analysis so that the record in all of its reexamination proceedings has the same evidence and so that NTP can rebut the erroneous claim in the Examiner's Answer that it failed to proffer any evidence to support arguments that the hearsay statements in the Aursoy email were not accurate and reliable.

COUNT I
(Denial of NTP Petition Dated January 3, 2007)

41. NTP repeats and realleges, as if fully set forth herein, all of the allegations contained in paragraphs 1 to 40.

42. The PTO's Decision Denying Petition dated March 30, 2007 denied NTP's January 3, 2007 Petition on procedural and merits grounds, finding the Petition was untimely and, additionally, that the proffered evidence was not sufficient as a matter of law to carry patent owner's burden of rebutting the status of the Telenor documents as prior art.

43. The determination that NTP's Petition was untimely is arbitrary, capricious, and contrary to law because the 60-day period relied upon by the PTO in 37 C.F.R. 1.181(f) was not applicable to NTP's Petition. In effect, the PTO erroneously treated NTP's January 3, 2007 Petition as a petition for reconsideration instead of as a original petition and hence incorrectly concluded the Petition was not timely filed.

44. Further, application of the 60-day time period in 37 C.F.R. 1.181(f) is discretionary and can be waived by the PTO. Under the circumstances, and particularly considering that the Telenor Analysis was admitted in the other 7 reexaminations, barring admission of the evidence based on the 60-day limit in § 1.181(f) was arbitrary and capricious.

45. The PTO's decision to exclude the evidence on the merits was also erroneous because the PTO applied the wrong standard in determining whether the evidence could be considered by an examiner in evaluating the authenticity and admissibility of the Telenor documents, and impermissibly shifted the burden of proof from the PTO to the patent owner.

46. The PTO's decision to exclude the Telenor Analysis was particularly egregious given its prior commitment to NTP, as documented in records filed in *ex parte* reexaminations, that evidence filed in any one of the examinations would be considered in all of the

reexaminations because the matters are entirely interconnected. The arguments advanced by both NTP and the PTO respecting the Telenor Analysis in briefing in the *ex parte* reexaminations apply with equal force in the *inter partes* case such that supplementing the record in the *inter partes* reexamination will involve no delay in the proceedings, including with respect to the oral arguments. By contrast, failure to admit the evidence into the record in the *inter partes* reexamination risks a conflicting result in that reexamination.

47. NTP has exhausted all administrative remedies available to it. The PTO's March 30, 2007 denial of NTP's Petition to admit the Telenor Analysis into evidence in the *inter partes* reexamination is final agency action. The PTO expressly stated in its Decision that "[t]he present decision is designated as a final agency action under 5 U.S.C. § 704."

48. The PTO's March 30, 2007 Decision is arbitrary, capricious, and contrary to law in violation of § 706 of the Administrative Procedure Act. NTP is entitled to an order from this Court reversing the March 30, 2007 Decision and ordering the PTO to supplement the record in the *inter partes* reexamination with the Telenor Analysis.

COUNT II

(Denial of NTP Petition Dated October 17, 2007)

49. NTP repeats and realleges, as if fully set forth herein, all of the allegations contained in paragraphs 1 to 40.

50. The PTO acknowledges in its Decision dated November 7, 2007, which denied NTP's October 17, 2007 Petition to supplement the record in the *inter partes* reexamination with the Telenor Analysis, that the Aursoy email is "relied upon by the examiner to establish the status of the Telenor documents as a printed publication having a definite publication date." See, Petition Decision of November 7, 2007, page 6 (emphasis in original).

51. In fact, NTP's Telenor Analysis directly challenges the Examiner's conclusion that the Telenor documents have a "definite publication date" based on the Aursoy email.

52. First, the Browne declaration and report suggest the Telenor documents were not originally assembled in volumes having the same order and content as the present volumes.

53. Second, the Browne declaration and report demonstrate some of the pages within the current volumes came from different batches of paper, and have trash marks indicating they were copied on different copy machines.

54. Third, the text of the individual pages was copied at a different time than the header on the top of the pages, suggesting text on various pages could have been altered at some point in time.

55. Fourth, cover pages of the volumes, which are the only pages containing date information, have different trash marks than pages within the volumes, suggesting they were copied on different machines, potentially at different times than other pages.

56. Finally, the binding material on each volume of the Telenor documents could be easily disassembled and reassembled, and there was evidence of disassembly.

57. Additionally, the Anderson declaration establishes that the Telenor documents were periodically checked out of the NTNU library, and thus were outside the custody and control of library staff on a number of occasions and for varying periods of time. The Anderson declaration further establishes that library staff made no effort to, and had no means of, verifying that the Telenor documents were returned to the library in an unaltered condition.

58. Taken together, the declarations and exhibits constituting the Telenor Analysis challenge whether the Telenor documents, as described in the Aursoy email, are "authentic", *i.e.*, whether they are exactly the same documents as were initially submitted to the NTNU library.

59. The Telenor Analysis also directly disputes the accuracy and reliability of the Aursoy email because it demonstrates Aursoy had no personal knowledge of the contents of the Telenor documents in 1989, and no means of verifying that the Telenor documents RIM submitted to the PTO in 2005 are the same as the documents submitted to the NTNU library in 1986 and 1989.

60. As demonstrated in its contemporaneously filed briefs, NTP proffered the Telenor Analysis for the express purpose of demonstrating the Telenor documents did not qualify as a "printed publication" having a "definite publication date" prior to the '592 Patent.

61. The allegations in the Examiner's Answer that NTP failed to proffer evidence challenging the accuracy and reliability of the Aursoy email is thus patently false. The evidence was indisputably *proffered* on several occasions.

62. NTP has exhausted all administrative remedies available to it. The PTO's June 19, 2008 denial of NTP's Petition to admit the Telenor Analysis into evidence for the purposes of disputing the claims asserted at pages 230-231 of the Examiner's Answer is final agency action. The PTO expressly stated in its Decision that "[t]he decision is designated as a final agency action under 5 U.S.C. § 704."

63. The PTO's June 19, 2008 Decision is arbitrary, capricious, and contrary to law in violation of § 706 of the Administrative Procedure Act. NTP is entitled to an order from this Court reversing the June 19, 2008 Decision and ordering the PTO to supplement that record in the *inter partes* reexamination with the Telenor Analysis.

COUNT III.

(Denial of NTP Petition Dated December 10, 2007)

64. NTP repeats and realleges, as if fully set forth herein, all of the allegations contained in paragraphs 1 to 40.

65. Regardless whether the record in the *inter partes* reexamination is supplemented to include the Telenor Analysis, the PTO acted in excess of its authority when it issued its Notification Regarding Defective Rebuttal Brief on November 9, 2007, effectively requiring NTP to redact pages 30-37 of its Rebuttal Brief or risk having the entire Rebuttal Brief stricken from the record.

66. Pages 30-37 rebutted the Examiner's contention—based on documents in the public record of the *inter partes* proceeding and without reference to the substance of the excluded Telenor Analysis—that NTP had failed to proffer evidence disputing the accuracy and reliability of the Aursoy email.

67. Pages 30-37 of the Rebuttal Brief further argued that the Examiner had in fact failed to produce evidence sufficient to meet the PTO's burden of proving the Telenor documents were printed publications. NTP argued that the Examiner erroneously relied on *Epstein* to draw an *inference* that the Aursoy email was accurate and reliable based on the false premise that NTP had failed to proffer contrary evidence.

68. Neither the applicable regulations nor the MPEP give the Examiner the sweeping authority exercised by the PTO to micro-manage the content of NTP's Rebuttal Brief.

69. The applicable regulation, 37 C.F.R. § 14.71, states that “[t]he rebuttal brief of the owner may be directed to the examiner’s answer and/or and respondent brief.” MPEP § 2678 provides that the rebuttal brief must be directed “to the issues raised in the examiner’s answer” and “must (A) clearly identify each issue, and (B) point out where the issue was raised in the examiner’s answer. . . .”

70. NTP's Supplemental Rebuttal Brief complied with the requirements of MPEP § 2678. It specifically identified pages 230-231 as the location in the Examiner's Answer where

the issue was raised, and explicitly stated that the issue challenged was the Examiner's contention that no evidence was "proffered."

71. The Examiner's authority under 37 C.F.R. § 41.71(e) to reject a rebuttal brief is limited to instances where the brief "does not comply with all the requirements of paragraphs (a) through (d) of this section. . . ." NTP's Rebuttal Brief did not fail to comply with these provisions.

72. Even if the Examiner disagrees that NTP's evidence in fact rebuts the accuracy or reliability of the Aursoy email, he has no authority to strike NTP's legal arguments, thus preventing this dispute from being submitted on its merits to the BPAI for review.

73. NTP has exhausted all administrative remedies available to it by law. The PTO's June 19, 2008 denial of NTP's Petition dated December 10, 2007 to withdraw the November 9, 2007 Notification Regarding Defective Rebuttal Brief is final agency action. The PTO expressly stated in its Decision that "[t]he decision is designated as a final agency action under 5 U.S.C. § 704."

74. The PTO's June 19, 2008 Decision is arbitrary, capricious, and contrary to law in violation of § 706 of the Administrative Procedure Act. NTP is entitled to an order from this Court reversing the June 19, 2008 Decision, ordering the PTO to withdraw its November 9 Notification, and directing the PTO to restore to the record the Rebuttal Brief originally filed by NTP, including pages 30-37.

PRAYER FOR RELIEF

NTP respectfully requests this Court to enter judgment against the defendant as follows:

On Count I

A. Reversing the Decision Denying Petition dated March 30, 2007; and

B. Directing the PTO to supplement the record in the *inter partes* reexamination with the Telenor Analysis as requested on January 3, 2007 in NTP's Petition Pursuant to 37 C.F.R. § 1.183 Or, Alternatively, 37 C.F.R. § 1.182, Or, Alternatively, 37 C.F.R. § 1.181 to Enter Evidence Against the Authenticity of the Telenor Documents Into the Record of the *Inter Partes* Proceeding.

On Count II

A. Reversing the Decision Denying Petition dated June 19, 2007; and

B. Directing the PTO to supplement the record in the *inter partes* reexamination with the Telenor Analysis as requested on October 17, 2007 in NTP's Original Petition Pursuant to 37 C.F.R. § 1.181, § 1.182 and § 1.183 in Response to Statements Made in the Examiner Answer to Enter into the Record for Appeal Evidence Against the Authenticity of the Telenor Documents.

On Count III

A. Reversing the Decision Denying Petition dated June 19, 2007; and

B. Directing the PTO to withdraw its November 9, 2007 Notification Regarding Defective Rebuttal Brief and allow NTP to present to the BPAI original, un-redacted Rebuttal Brief, including page 30-37.

On All Counts

For such other and further relief as may be just and proper.

NTP, Inc.

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